

### **REMARKS**

Claims 24 and 34 have been amended. Claims 24-34 are pending. A Petition for Extension of Time and a Terminal Disclaimer are being filed concurrently herewith.

Claims 24-31, 33 and 34 stand rejected for obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,864,493. Claims 24, 29, 30 and 32 stand rejected for obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,838,667.

A Terminal Disclaimer complying with 37 C.F.R. 1.321(c) is filed herewith. Applicant respectfully requests the obviousness-type double patenting rejection of claims 24-34 be withdrawn.

Claims 24-31, 33 and 34 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 5,627,373 ("Keese").

Keese is directed to an electron beam alignment and correction of electron beam astigmatism in scanning electron microscopes. According to Keese, (1) the focus of the objective lens is varied so as to calculate the amount of image translation for the images obtained at each of the extremes of the focus range; (2) the control circuit 50 supplies control signals LC1 and LC2 to alignment coil 22; (3) the pattern recognition circuit 48 determines information contained in a signal IND that indicates the position of the image of boundary portion; and (4) the control circuit 50 analyzes the signal IND and calculates corrections to beam alignment. Keese does not disclose, or suggest the calculation of a value that indicates "the relationship between the amount of image translation and beam alignment."

The rejection of claim 1 appears to rely on the doctrine of inherency. Please note, however, that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency. To establish inherency, the reference must make clear that the missing descriptive matter is necessarily present in the thing described. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993).

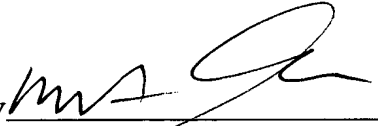
Further, even if the "calculation of the value that indicates the relationship between the amount of image translation and beam alignment" were to be taught, claim 24 as amended would not be anticipated by Keese. The present invention calculates the signal supplied to the alignment deflector after calculating a parameter varied according to an operation condition of the optical element. The condition of the optical element varies based on several conditions, and if the signal supplied to the deflector is calculated without determining the parameter that indicates the condition, accurate alignment cannot be achieved. Keese does not disclose how the relationship between the translation and the alignment is calculated. For this reason as well, Applicants respectfully request the 35 U.S.C. §102(b) rejection of claim 24 be withdrawn. For at least these reasons, dependent claims 25-31, 33 are allowable. Claim 32 should be allowable along with claim 24 for other reasons.

Claim 34 recites, in part, "calculating parameter varied according to an operation condition of the optical element, and supplied to the alignment deflector based on the calculated parameter." Applicants submit that claim 34 is allowable for at least the reasons set forth above. Therefore, claim 34 is patentable over Keese.

In view of the above amendments, Applicants believe the pending application is in condition for allowance.

Dated: May 15, 2006

Respectfully submitted,

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